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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,190	07/03/2003	Karl K. LaFleur	12584.37	4957
27683	7590	04/13/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			HOUSE, LETORIA G	
			ART UNIT	PAPER NUMBER

3672

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,190

Applicant(s)

LAFLEUR, KARL K.

Examiner

Letoria House

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 3, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the phone conversation with Randall Brown in which it was pointed out that originally filed claim 17 was not included in the office action mailed March 24, 2005. The first office action has been updated.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hollow cylindrical sleeve of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims 1, 10 the inventor recites the use of a "movable seal" and further references a "movable sleeve" coupled to the "movable seal" in claims 4, 6, and 11. In claims 15 and 16 the inventor recites a method for operating a "movable valve". However the terminology "movable seal" is mainly used in the abstract to describe the invention. Other parts of the specification utilize the terminology "movable sleeve." In using different terms for components coupled to the actuating device, the inventor confuses the reader. The inventor has not used consistent nomenclature nor has the inventor clearly specified whether the terminology cited above is mutually inclusive. The inventor also fails to demonstrate the use of a movable, hollow cylindrical sleeve around the first fluid passage as recited in claim 3. Therefore, claims 1-17 are rejected.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5, 9-10, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fournier, Jr. et al., U.S. Patent 6,832,656, in view of Newman et al., U.S. Patent 5,794,703. Fournier teaches a down-hole tool for attachment in a production string in a well bore having a casing comprising: a tubular housing having a first fluid passage and a longitudinal axis; a movable seal coupled to an exterior of a housing, the seal adapted to substantially block a flow of fluid through the first fluid passage when the seal is in a closed position and to allow the flow of fluid when the seal is in an open position. See Figure 3, column 4 lines 34-44. Fournier also recites an actuating device in the form of an arm coupled to the movable seal such that in response to a first predetermined condition the arm moves causing the movable seal to move from the closed position to the open position, see column 2 lines 5-11, and a

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valve in communication with the first fluid passage, such that upon a second predetermined condition the valve allows the flow of fluid through a second fluid passage. See column 4 lines 6-8; 34-44.

Fournier et al. further teaches a device wherein the first fluid passage comprises a longitudinal fluid passage and at least one fluid exit port, see column 4 lines 7-8, a valve comprising an entrance port of the second fluid passageway and a ball or other forms of valves so long as they are capable of selectively permitting fluid flow through the tool. See column 4 lines 23-25. Additionally, Fournier et al. teaches a down-hole tool comprising a guide mounted to the body to assist in centralizing it in the casing and to protect the tool as it is inserted into the casing. See column 4 lines 8-10.

Fournier et al. does not teach the use of scissor arms or the like for actuating the valve from a closed to open position, and also does not teach the use of an anchor coupled to the housing to allow the movable sleeve to move relative to the housing. However, Newman et al. discloses an actuating device comprising a plurality of scissor arms coupled to a movable seal such that in response to a first predetermined condition, the scissor arms move laterally causing the movable seal to move longitudinally from the closed position to the open position. See Figure 1B and column 5 lines 56-69. Newman et al. also teaches a down-hole tool comprising an anchor coupled to the housing to allow the movable sleeve to move relative to the housing. See column 5 lines 50-60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the actuating sleeve of Fournier Jr. et al. to

include scissor arms of Newman et al. in order to simplify actuation while providing additional means of centering and securing the tool within the casing string.

With regard to method claims 15-17, the steps recited would necessarily be performed by the modification of Fournier Jr. et al. in view of Newman et al.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fournier Jr. et al. in view of Newman et al. as applied to claims 1-3, 5, 9-10, and 12-17 above, and further in view of Streich, U.S. Patent 4,067,358. Although Fournier Jr. et al. teaches the use of various valve types, the valve shown in the combination is a rotatable ball valve, not a spring biased valve as recited in the claims. Streich teaches that it is notoriously conventional to utilize spring biased valves for filling and circulating well maintenance. Additionally, Streich teaches the use of a ball or plunger type valve structure. Therefore, it would have been obvious to one skilled in the art at the time of the invention to replace the rotating ball valve of Fournier et al. in view of Newman et al. with the spring biased ball or plunger valve of Streich in order to simplify the device, reduce manufacturing costs, and to simplify tool repair.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Armell, U.S. Patent 4,790,381 is relevant in that it discloses a tubular member capable of fluid circulation with two arm linkages comprising a sleeve, slidably mounted to a center tube. Von Gonten, Jr., U.S. Patent 4,944,349 teaches a tubing circulating valve having a tubular member with ports through the wall thereof

having a sliding sleeve disposed around the outside surface for passage of fluid, wherein the sliding sleeve is shifted with respect to the tubular member to a circulating position in which fluid is allowed to flow into the annulus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Letoria House whose telephone number is (571) 272-8118. The examiner can normally be reached on M-F, 7:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

LGH